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EXAMINER

STRANGE, AARON N

ART UNIT	PAPER NUMBER
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2448

NOTIFICATION DATE	DELIVERY MODE
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05/29/2013

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/783,726	Applicant(s) LAZARIDIS ET AL.	
	Examiner AARON STRANGE	Art Unit 2448	AIA (First Inventor to File) Status No

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2013.
☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 102-109, 111, 112 and 122-129 is/are pending in the application.
5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 102-109, 111, 112 and 122-129 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

- a) ☐ All b) ☐ Some c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Interim copies:

- a) ☐ All b) ☐ Some c) ☐ None of the: Interim copies of the priority documents have been received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 3) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20130507</u> . | 4) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 5/10/2013, with respect to the rejection of claims 102-109, 111, 112 and 122-129 under 35 U.S.C. § 112 have been fully considered and are persuasive. Accordingly, that rejection has been withdrawn.

2. Regarding Applicant's assertion that the registration commands disclosed by Eggleston (col. 6, ll. 25-55) "function as commands or instructions to the server to facilitate downloading of messages" (Remarks 12), it is noted that the current claim language only precludes "commands from the wireless ... device to facilitate downloading of the user data items" *in the context of the claimed processing step*.

Claim 102 requires "without commands", "processing" and claim 122 requires "processing", "without commands". The language of the current claims fails to preclude receiving commands prior to or after the processing step. Eggleston's "registration commands" occur prior to even checking for received messages (col. 6, ll. 58-63), so it is clear the "processing" step is performed without the registration commands.

3. With further regard to claims 102 and 122, even if the claims language precluded any receipt of "registration" commands from the client device, such a feature was known in the art at the time the invention was made. Namekawa (US 6,237,027) teaches redirecting messages from a host system to a wireless device without any "registration messages" or any other commands from the wireless mobile device, which simply waits

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in a “waiting state until the call is issued from the other party side” (col. 4, ll. 51-54; col. 5, ll. 5-13; col. 8, ll. 6-9; col. 10, ll. 28-51). This advantageously eliminates the need for the mobile device to access the host system to determine whether messages have arrived (col. 11, ll. 25-29).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 102, 103, 109, 111, 112, 122 and 127-129 are rejected under 35 U.S.C. 102(e) as being anticipated by Namekawa (US 6,237,027).

6. With regard to claim 102, Namekawa discloses a method of pushing user data items from a messaging host system to a wireless mobile data communication device that is associated with a user having a mailbox at the messaging host system, the method comprising:

receiving notifications at a redirector component indicating receipt of user data items by the messaging host system, wherein the notifications are received in response

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to receipt of the user data items at the messaging host system (flag is set when a message arrives at the host system)(col. 8, ll. 4-25);

without commands from the wireless mobile data communication device to facilitate downloading of user data items (mobile device need not contact the host computer)(col. 10, ll. 33-34; col. 11, ll. 25-29), processing the user data items by the redirector component to add address information associated with the wireless mobile data communication device (subscriber number is added and used to contact subscriber for message forwarding)(col. 9, ll. 21-46) ; and

causing to continuously redirect the user data items to the wireless mobile data communication device over a wireless network (col. 8, ll. 20-25; col. 10, ll. 17-25).

7. With regard to claim 103, Namekawa further discloses that the redirector component is operating on the messaging host system (col. 8, ll. 10-15).

8. With regard to claim 109, Namekawa further discloses that the user data items comprise email messages (col. 8, ll. 15-20).

9. With regard to claim 111, Namekawa further discloses that the user data items are continuously redirected to the wireless mobile data communication device over the wireless network via a wireless gateway (base station 8) disposed between a wide area network and the wireless network (fig. 1; col. 3, l. 56 to col. 4, l. 17).

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10. With regard to claim 112, Namekawa further discloses storing the user data items at a data store associated with the messaging host system (col. 8, ll. 26-29).

11. Claims 122 and 127-129 are rejected under the same rationale as claims 102, 109, 111 and 112, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are explicitly or inherently taught by the above cited art.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 102-104, 106-109, 111, 122 and 124-129 are rejected under 35 U.S.C. § 103(a) as being unpatentable over AirMobile (Software for Lotus cc:Mail Wireless, Communication Client Guide, Motorola, 1995) in view of Eggleston et al. (U.S. Patent No. 5,764,899, hereinafter "Eggleston").

14. With regard to claim 102, AirMobile discloses a method of pushing user data items from a messaging host system ("communication server") to a wireless mobile data communications device that is associated with a user having a mailbox at the

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messaging host system (p. 9, "Communication Server," p. 10, "User Profile Database," pp. 15-16, wherein mail is received and stored at the communication server, and the mail account is associated with a mobile device according the device ID), the method comprising:

receiving notifications at a redirector component indicating receipt of user data items by the messaging host system, where the notifications are received in response to receipt of the user data items at the messaging host system (newly received messages are immediately downloaded when they arrive)(p. 30-31);

without commands from the wireless mobile data communication device to facilitate downloading of the user data items (messages are automatically and immediately forwarded to the client)(p. 31 ¶1-3), processing the user data items by the redirector component to add address information associated with the wireless mobile data communication device (address information is required for delivery to the mobile client)(p. 31, ¶1-3);

causing to redirect the user data items to the wireless mobile data communication device over a wireless network (messages are pushed to the portable PC)(p. 31).

While AirMobile discloses the invention substantially as claimed, it fails to specifically disclose that the user data items are "continuously redirected", regardless of the availability of the wireless device.

Eggleston discloses a substantially identical system for redirecting messages to a wireless device. Eggleston teaches continuously redirecting data items via a virtual

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session and identifies the procedure for removing a client from active status and stop attempting to deliver data as a process that is "*preferably* included in the VSM" (col. 7, ll. 37-40). A preferable feature is not required, and one of ordinary skill in the art would have understood Eggleston's disclosure to mean that the system properly operate, albeit less efficiently, with this feature removed. Therefore, Eggleston at least suggests a system where messages are continuously forwarded, regardless of the availability of the client device. Eggleston additionally discloses that messages are delivered "in a sessionless mode" (col. 7, ll. 10-14).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to continuously forward the data items to the mobile device, regardless of the device's availability, to ensure the client will be immediately notified of outbound data upon its return to availability, without requiring the device to login again (Eggleston; col. 7, ll. 37-58).

15. With regard to claims 103 and 104, Eggleston further discloses that the redirector component may operate on the messaging host system or another host system coupled to the messaging host system via the network (VSM and post office may be on the same server or different servers) (col. 4, ll. 58-67).

16. With regard to claim 106, Eggleston further discloses that messages sent between the wired and wireless systems can be compressed (col. 11, lines 63-67). Given this knowledge, it would have been obvious to a person having ordinary skill in

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the art to compress the messages, prior to transmission to the gateway, and to decompress the messages at the mobile device, as suggested by Eggleston, in order to increase available bandwidth and to provide faster and less expensive communications (see Eggleston, col. 12, lines 7-9).

17. With regard to claim 107, AirMobile further discloses that the processing step further comprises encoding the copy of the user data item (e.g. transforming a message into the required transmission protocol for the wireless network being utilizing prior to pushing a message to the user) (additionally compressing as set forth with regard to claim 106 is a form of encoding).

18. With regard to claim 108, Examiner takes official notice that the Multipurpose Internet Mail Extensions protocol was widely known and used to communicate email messages between devices at the time of Applicant's invention. Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to encode messages using the MIME protocol within AirMobile's system in order to communicate messages between devices using a known reliable protocol.

19. With regard to claim 109, AirMobile further discloses that the user data items comprise email messages (pg. 38, "Sending/Transmitting e-mail messages").

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20. With regard to claim 111, AirMobile further discloses that the user data items are continuously redirected to the wireless mobile data communication device over the wireless network via a wireless gateway disposed between a wide area network and the wireless network (see pg 9, Figure 1-1, a gateway is required to interface between the networks).

21. With regard to claim 112, AirMobile further discloses that the step of storing the user data item at the data store associated with the messaging host system (p. 9, "Communication Server," p. 10, "User Profile Database," pp. 15-16, wherein mail is received and stored at the communication server, and the mail account is associated with a mobile device according the device ID).

22. Claims 122 and 124-129 are rejected using a similar rationale as applied to claims 102-104, 106-109, 111 and 112.

23. Claims 105 and 123 are rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile Server (AirMobile Wireless Software for Lotus cc:Mail, Communication Server Guide, Motorola, 1995), in view of AirMobile Client (AirMobile Wireless Software for Lotus cc:Mail, Communication Client Guide, Motorola, 1995) further in view of Eggleston et al. (U.S. Patent No. 5,764,899, hereinafter "Eggleston") further in view of Murota (U.S. Patent No. 6,289,105).

Note, the AirMobile Server and AirMobile Client guide present different aspects of the same system, and are therefore are treated as a single system for the purposes of this rejection. They are hereinafter referred to together as "AirMobile" with specific citations to the Server guide as "AirMobileS" and the Client guide as "AirMobileC."

24. With regard to claim 105 and 123, AirMobileS disclosed sending messages from the cc:Mail server to the mobile device in a secure fashion (AirMobileS, p. 25, bullet 1 "secure and authenticated virtual wireless communication channel between your laptop and your LAN-based cc:Mail server") however, AirMobile does not disclose using encryption for sending messages in a secure fashion. Nonetheless the use of encryption to send messages securely was widely known in the art at the time of Applicant's invention, as evidenced by at least Murota.

In a similar email system, Murota disclosed encrypting e-mail messages between a sender and a receiver, wherein a message is encrypted at the sending end, is then transmitted over the network to the receiving end, and is finally decrypted at the receiving computer (col. 1, lines 23-48). Murota further disclosed that such an encryption scheme is advantageous because it prevents leaks of secret information to outside, non-intended parties (Murota, col. 1, lines 49-53).

Thus, given the teaching of Murota, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention include an encryption function, as taught by Murota, in conjunction with the redirector component of AirMobile such that

messages sent between the AirMobile server and mobile devices are encrypted, in order to prevent outside parties from having access to secret or classified messages.

Conclusion

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Strange/
Primary Examiner, Art Unit 2448